

REMARKS

Claims 1-5, 7, 9, and 11 are pending and under consideration.

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

This response is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this response is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding.

Entry of Amendment under 37 C.F.R. § 1.116

The Applicant requests entry of this Rule 116 Response because the response does not alter the scope of the claims and places the application at least into a better form for purposes of appeal and because the Examiner has cited new art in rejecting the claims. No new features or new issues are being raised.

The Manual of Patent Examining Procedures (M.P.E.P.) sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The M.P.E.P. further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

I. Rejections under 35 U.S.C. § 103

In the Office Action, at pages 2-6, claims 1, 3-4, 7, and 9 were rejected under 35 USC § 103(a) as being unpatentable over Tamagaki et al. (U.S. Patent No. 5,452,105) in view of Kanno et al. (U.S. Patent No. 6,263,118) and Tomita et al. (U.S. Patent App. Pub. No. 2003/0100354).

In the Office Action, at pages 6-7, claim 2 was rejected under 35 USC § 103(a) as being unpatentable over Tamagaki et al. in view of Kanno et al. and Tomita et al. and further in view of Toshihiro (JP 9-200507).

The cited references, alone or in combination, do not discuss or suggest:

an image reading unit configured to receive a medium including a colorless and transparent carrier sheet that includes a combination instruction mark in a predetermined position thereon and holds an original therein and configured to read a front side image and a rear side image from a front side and a rear side of the original,

respectively,
as recited in claim 1.

Claim 1, as recited, provides for a colorless and transparent carrier sheet that holds an original therein and permits the image reading unit to read a front side image and a rear side image from a front side and a rear side of the original. The Examiner, at page 4 of the Office Action, acknowledges that the proposed combination of Tamagaki et al. and Kanno et al. does not teach a medium including a colorless and transparent carrier sheet that includes a combination instruction mark in a predetermined position thereon and holds an original therein. The Examiner attempts to make up for this deficiency in the proposed combination of Tamagaki et al. and Kanno et al. with Tomita et al. However, this is submitted to be incorrect because Tomita et al. also does not teach a medium including a colorless and transparent carrier sheet that includes a combination instruction mark in a predetermined position thereon and holds an original therein.

Tomita et al., as relied on by the Examiner, does not provide a carrier sheet that is transparent and colorless. The carrier sheet of Tomita et al. is merely provided for adding thickness to a document to be scanned and merely includes a single transparent sheet 3 that is adhered to a support sheet 2 (see Fig. 1 and paragraph [0044]). Tomita et al. further discloses that the support surface 2a of the support sheet 2 has a different color than the document to be scanned and that a support surface 2a of the support sheet 2 is black in color (see paragraph [0045]). As such, the carrier sheet of Tomita et al. does not allow a scanning apparatus to read both a front side image and a rear side image from a front side and a rear side of the original document.

Furthermore, because the carrier sheet of Tomita et al. is not transparent and colorless, Tomita et al. would render the prior art invention being modified unsatisfactory for its intended purpose. The Examiner, at page 4 of the Office Action, indicates that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the proposed combination of Tamagaki et al. and Kanno et al. by including instruction marks on a carrier sheet taught by Tomita et al. in order to avoid sheet feeding malfunctions and to identify attributes of the document in the carrier sheet. However, it is respectfully submitted that there is no motivation to combine the references as the Examiner has indicated. MPEP section 2143.01 clearly states that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification (see *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). A person of ordinary skill in the art would clearly appreciate that the Examiner's proposed

modification would render the combined Tamagaki et al. and Kanno et al. apparatus unsatisfactory for its intended purpose. The Examiner's proposed combination of Tamagaki et al. and Kanno et al. has been provided for reading double sided documents and forming and combining multiple images on a single sheet. In fact, at page 3 of the Office Action, the Examiner stated that it would have been obvious to modify Tamagaki et al. with Kanno et al. in order to reduce the amount of paper used in copying or printing. However, the carrier sheet of Tomita et al. does not allow for a document contained therein to be read on both sides of the document. In fact, as mentioned above, the carrier sheet of Tomita et al. specifically requires a colored sheet to be used as a support sheet, thus actually teaching away from a colorless and transparent carrier sheet that allows images to be scanned from each side of the document. Therefore, if the carrier sheet of Tomita et al. was used for feeding a document through the combined Tamagaki et al. and Kanno et al. apparatus, the combined Tamagaki et al. and Kanno et al. apparatus would not be able to read a double sided document and, therefore, would not be able to form and combine multiple images on a single sheet and reduce the amount of paper used, thus rendering the combined Tamagaki et al. and Kanno et al. apparatus unsatisfactory for its intended purpose.

To summarize, (1) Tamagaki et al., Kanno et al., and Tomita et al., alone or in combination, do not discuss or suggest all of the features of claim 1, and (2) there is no motivation for combining the references because the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Therefore, independent claim 1 patentably distinguishes over Tamagaki et al., Kanno et al., and Tomita et al.. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 2-5 depend either directly or indirectly from claim 1, and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 2-5 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

Claim 7 recites:

at the image reading unit, receiving a medium including a colorless and transparent carrier sheet that includes a combination instruction mark in a predetermined position thereon and holds an original therein and reading a front side image and a rear side image from a front side and a rear side of the original, respectively.

Tamagaki et al., Kanno et al., and Tomita et al., alone or in combination, do not discuss or suggest all of the features of claim 7, and there is no motivation for combining the references because the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Therefore, independent claim 7 patentably distinguishes over Tamagaki et al., Kanno et al., and Tomita et al.. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 9 and 11 depend either directly or indirectly from claim 7, and include all the features of claim 7, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 9 and 11 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

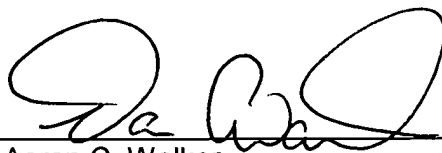
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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